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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/357,957	07/21/1999	RICHARD LEVY	01064.0011-0	9917

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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/19/2001

12

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D -12

Office Action Summary

Application No. 09/357,957	Applicant(s) LEVY
Examiner MEDLEY	Group Art Unit 1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 09/09/01.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 29-43 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 29-43 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

The rejection over claim 1 is withdrawn in view of applicant's cancellation of claim 1.

The objecting of claim 38 and the 112 second paragraph rejection of claim 36-38 and 40 are withdrawn in view of applicants amendments to the said claims.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Dwp Claims 29-43 remain rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The step for "prior to or after exposing the super absorbent polymer, SAP, to water or high humidity environment, 80% R.H., in the form of a powder, flakes or granules,(an) and mixing the lubricant in a conventional mixer wherein the said lubricant is entrapped by (oris) or is taken up by the SAP that has been swollen with water or in high humidity" are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The disclosure in the last paragraph of page 28 and the first two paragraph of page 29 (that corresponds to the last three paragraphs of page 31 of related pending application 09/359,809) demonstrates that said particular process step features were considered essential by the applicant, but not reflected in the claims which are rejected.

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Deny Claims 29-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject of claim 29 (and its dependent claims) in lines 4-7 for "friction is a petroleum... and mixtures thereof" is not properly described in the application as filed. The first full paragraph on page 18 of the instant application provides for each individually as a friction additive.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Deny Claim 29 (and its dependent claims) is indefinite for the last line phrase "and mixtures thereof" which makes the Markush grouping improper. The rejection may be overcome with the substitution of "or" in place of "and" in the said phrase.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 29, 35 and 42 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by Admitted Prior Art for reasons made of record in Paper No. 10 dated July 5, 2001.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29, 35-36 and 41-43 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sayad et al 3,336,225 combined with Admitted Prior Art in view of Hopkins, Jr. 5,362,766 et al and Geursen et al W093/182,263 (and its US counterpart 5,534,304) for reasons made of record in Paper No. 10 dated July 5, 2000.

Claims 30-34 and 37-40 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sayad et al 3,336,225 combined with Admitted Prior Art in view of Hopkins, Jr. et al 5,362,766 and Geursen et al WO93/182,263 (and its US counterpart 5,534,304 as applied to claims 29, 35-36 and 41-43 above, and further in view of Schey and Booser for reasons made of record in Paper No. 10 dated July 5, 2000.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 29-43 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 57-71 of copending Application No. 09/359,809. Although the conflicting claims are not identical, they are not patentably distinct from each other because for reasons made of record in Paper No. 10 dated July 5, 2001.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed September 7, 2001 have been fully considered but they are not persuasive.

The examiner maintains the position stated of record that claims 29-43 are properly rejected under the first paragraph of 35 USC Section 112. The claims fail to provide the step for "prior to or after exposing the super-absorbent polymer (SAP) to water or high humidity environment, 80% R.H., in the form of powders, flakes or granules, and mixing the lubricant in a conventional mixer wherein the said lubricant is entrapped by or is taken up by the SAP that has swollen with water or in high humidity" which is critical or essential to the practice of the invention as is set forth in the last paragraph of page 28 and the first two paragraph of page 29

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(that corresponds to the last three paragraph on page 31 of related US Application 09/359,809) of the instant application.

Applicant alleges that the disclosure describes the invention broadly and that the invention should not be limited to preferred features. The examiner agrees with applicant's allegation. However, the features which the examiner has determined to be the critical features of the instant application appear to be the broad method and not the preferred method. In reviewing the instant application the examiner did not find any evidence that the said critical broad features determined by the examiner to be critical were the preferred features as alleged by applicants. To clarify the record pages 35-36 of the instant application are directed to canceled claims 27-28 and the Abstract Of The Disclosure.

The 102 (b) rejection of claim 1 over Hopkins is deemed moot in view of applicants cancellation of claim 1.

Applicant alleges that the Examiner has applied Brannon-Pappas in a manner to amplify the Levy disclosure. It is noted of record that while a 102 rejection normally requires a single reference (Studiengesellschaft Kohle v. Dart Ind. Inc. 220 USPQ 841 (CAFC 1984), other reference may be used to explain teachings. In re Baxter Travenol Labs 21 USPQ 2d 1281 (CAFC 1991).

The examiner maintains the position of record that Levy's 251 combined with Prior art Brannon-anticipates claims 29, 35 and 42 with teachings directed to a composition note column 1-8, Example I comprising water, SuperSorb^R, (which absorbs greater than 100 times its weight in

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water) and Arosurf[®] MSF (fatty acid esters, ethers and alcohols) which functions as a film forming agent, as a surfactant emulsifier, or as an insecticidal, note column 17 lines 42-54 of Levy '251.

The Arosurf[®] MSF falls within applicants claim 42 for water and lubricant because the Arosurf[®] MSF not only acts a surfactant but as a dispersant, and it falls within claim 42 synthetic oil.

It appears that applicant are arguing against the, Sayad, the Admitted Prior Art, Hopkins and Guersen, references individually.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

While the Sayad reference is silent as to its SAP having a MW of about 2 million having water absorbance of greater than 100 times its weights, the Admitted Prior Art, Hopkins and the Geursen Patents provide teachings that the polymers of Sayad are known and are known for absorbing greater than 100 times its weight in water and especially are combined with conventional additives and lubricants for reducing frictions.

In response to applicant's argument that Hopkins '766 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the composition and process for producing said

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composition include the composition of the instant claims as well as the composition of Sayad and therefore is properly combined because SAP and lubricant solution are the same..

In response to applicant's argument that Guerson does not teach or suggest super absorbent polymers than can absorb greater than about 100 times their weight in water for the process or product disclosed, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Geursen et al WO93/182,263 teaches a water-in-oil emulsion, note page 6 lines 23-24, comprising a superabsorbent polymer, column 6 lines 5-end, and provides for the further inclusion of lubricants and conventional additives, page 7, line 6 to page 8, line 17 and page 16, line 25 to page 17 line 12.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the swell value of the substrate containing a superabsorbent polymer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Applicants' discussion at page 10 and the top of page 11 of the amendment dated September 7, 2001 is irrelevant with respect to the water absorbance of the SAP prior to adding it to a composition.

The Examiner maintains the position stated of record that Schey and Booser teachings of conventional and well-known lubricants and friction additives for surfaces are properly combined with the teachings of Sayad combined with Admitted Prior art in view of Hopkins, Jr. et al. 5, 362,304 which render obvious claims 20-34 and 37-40.

The double patent rejection is maintained and the 102 and 103 rejections have been maintained. In the event that applicant overcomes both the 102 and 103 rejections, the double patent rejection will be withdrawn in the first application that is deemed to be allowable according to MPEP 804 (I.) (B) p. 300-19 August 2001, and a terminal disclaimer will be required in the second application.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

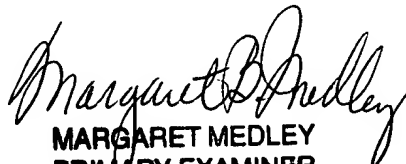
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday-Friday from 7:30 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vaser Jagannathan, can be reached on (703) 306-2277. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


MARGARET MEDLEY
PRIMARY EXAMINER

Medley/af

December 18, 2001